

### R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

### SUPPORT FOR THE CLAIM AMENDMENTS

Support for the claim amendments may be found in the specification, for example, on page 14 line 8-page 15 line 10, page 21 lines 3-15 and FIGS. 3 and 6, as originally filed. Thus, no new matter has been added.

### DOUBLE PATENTING

The provisional rejection of claims 1-16 under the judicially created doctrine of obviousness-type double patenting has been obviated by the attached terminal disclaimer and should be withdrawn.

### OBJECTION TO THE SPECIFICATION

The objection to the title is respectfully traversed and should be withdrawn.

The objection to the Brief Summary of the Invention section of the application is respectfully traversed and should be withdrawn.

The objection to page 4, line 18 of the specification is respectfully traversed and should be withdrawn.

The objection to the abstract is respectfully traversed and should be withdrawn.

The current title "Programmable Protocol Processing Engine for Network Packet Devices" appears to be indicative of an invention to which the claims are directed. In particular, claim 1 provides (in part) steps for processing (e.g., programmable protocol processing engine) a first parameter in an incoming packet (e.g., network packets). As such, the objection to the title should be withdrawn.

Regarding the Brief Summary of the Invention, MPEP 608.01(d) states:

Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, **the summary should be directed to the specific invention being claimed...** (emphasis added)

The assertion in the Office Action that the summary "should contain [a] brief description of the disclosed subject matter" does not appear to be consistent with the MPEP text reproduced above. As such, the objection to the Brief Summary of the Invention should be withdrawn.

Regarding page 4, line 18 of the specification, peripherals are a type of circuit. Therefore, "an external circuit" properly describes the subject of the figure. As such, the objection to page 4, line 18 of the specification should be withdrawn.

Regarding the abstract, the "Guidelines for the Preparation of Patent Abstracts" section in MPEP §608.01(b) appears to be silent regarding (i) disallowing the word "may", (ii) inclusion of "what the applicant has mentioned about the reasoning of the invention" and (iii) "clearly stat[ing] the goal of the invention". Therefore, the Examiner is respectfully requested to either (i) clearly identify the authority for the above assertions or (ii) withdraw the objection.

#### **OBJECTION TO DRAWINGS**

The request to label FIG. 1 by a legend such as --Prior Art-- is respectfully traversed and should be withdrawn. FIG. 1 already has the legend "conventional". Adding a second legend would not appear to be useful in understanding the figure.

Regarding FIG. 2, page 13 line 20-page 14 line 1 of the specification states, "The external circuit 108 may be implemented a[s] one or more circuits 132N-Q. The circuits 132A-Q may be implemented as peripheral blocks or peripheral circuits." Therefore, the "circuits" mentioned on page 5, lines 10-11 are the "External Peripherals" of block 108 shown in FIG. 2. As such, the objection to the drawings should be withdrawn.

**CLAIM REJECTIONS UNDER 35 U.S.C. §102**

The rejection of claims 1-8 and 10-16 under 35 U.S.C. §102(e) as being anticipated by Ogawa et al. '966 (hereafter Ogawa) is respectfully traversed and should be withdrawn.

The Examiner is respectfully requested to refrain from omnibus rejections that simply list all of the claimed elements and then assert that the claimed elements are disclosed somewhere among a figure and a large section of text (see MPEP 707.07(d)). As such, Applicant's representative respectfully requests that a next rejection (if any) be presented in a non-final Office Action. No reasonable opportunity has been provided to respond to the rejections due to large ambiguities in the current rejections.

Ogawa concerns a data receiving device which enables simultaneous execution of processes of a plurality of protocol hierarchies and generates header end signals (Title).

Claim 1 provides a step for reading a pointer for a first parameter within an incoming packet (from a first network). Despite the assertion on page 5 of the Office Action, column 8, lines 42-58 of Ogawa appear to be silent regarding a reading step as presently claimed. Furthermore, no application of Ogawa to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established.

Claim 1 further provides a step for processing the first parameter in accordance with the pointer to produce a second

parameter. Despite the assertion on page 5 of the Office Action, column 7, lines 26-53 of Ogawa appear to be silent regarding a processing step as presently claimed. Furthermore, no application of Ogawa to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established.

Claim 1 further provide a step for presenting an outgoing packet containing the second parameter for a second network. Despite the assertion on page 5 of the Office Action, column 7 line 27 thru column 9 line 24 of Ogawa appears to be silent regarding a presenting step as presently claimed. Furthermore, no application of Ogawa to the claim is provided in the Office Action. Therefore, *prima facie* anticipation has not been established. As such, the Examiner is respectfully requested to either (i) provide a clear and concise explanation how the cited paragraphs of Ogawa allegedly anticipate the claim or (ii) withdraw the rejection of claim 1.

Claim 16 provides a structure performing the steps of claim 1. As noted above for claim 1, *prima facie* anticipation has not been established for the steps as presently claimed. Furthermore, no evidence or arguments are presented in the Office Action specifically directed to the claimed structure. Therefore, *prima facie* anticipation has not been established. As such, the Examiner is respectfully requested to either (i) provide a clear and concise explanation how the cited paragraphs of Ogawa allegedly

anticipate the claimed structure or (ii) withdraw the rejection of claim 16.

Regarding claims 2-8 and 9-15, the Office Action fails to provide evidence that Ogawa expressly or inherently discloses the dependent claims. Instead, the Office Action repeatedly cites the same paragraphs of Ogawa with no explanation how the cited information anticipates the claims. Therefore, *prima facie* anticipation has not been established. As such, the Examiner is respectfully requested to either (i) provide a clear and concise explanation how the cited paragraphs of Ogawa allegedly anticipate the claims or (ii) withdraw the rejections of claims 2-8 and 9-15.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. §103**

The rejection of claim 9 under 35 U.S.C. §103(a) as being unpatentable over Ogawa in view of "Official Notice" is respectfully traversed and should be withdrawn.

Regarding claim 9, clear and particular evidence of motivation to modify Ogawa to make processing of a first parameter non-programmable is not provided in the Office Action as required by MPEP §2142. Furthermore, the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness (MPEP §2143.01). As such, *prima facie* obviousness has not been established and the rejection of claim 9 should be withdrawn.

### COMPLETENESS OF THE OFFICE ACTION

Aside from a notice of allowance, Applicant's representative respectfully requests any further action on the merits be presented as a non-final action. 37 CFR §1.104(b) states:

(b) *Completeness of examiner's action.* The examiner's **action will be complete as to all matters**, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters of form need not be raised by the examiner until a claim is found allowable. (Emphasis added)

No substantive arguments were presented in the Office Action directed to claims 1-16 explaining how the cited paragraphs of Ogawa anticipate the claim limitations. As such, the Office Action is incomplete.

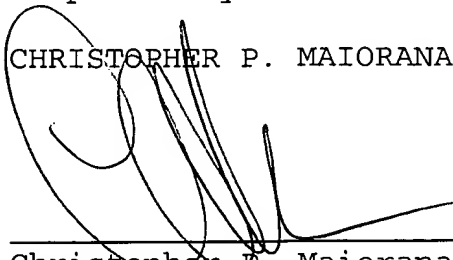
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office  
Account No. 50-0541.

Respectfully submitted,

CHRISTOPHER P. MAIORANA, P.C.

A handwritten signature in black ink, appearing to read 'Christopher P. Maiorana', is written over a horizontal line.

Christopher P. Maiorana  
Registration No. 42,829  
24840 Harper Avenue, Suite 100  
St. Clair Shores, MI 48080  
(586) 498-0670

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